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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,045	08/28/2001	J. Smith Doss	RSW920010041US1	5733

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EXAMINER
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CORRIELUS, JEAN M

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/941,045

**Applicant(s)**

DOSS ET AL.

**Examiner**

Jean M Corrielus

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-59, 61-104 and 106-141 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-59, 61-104 and 106-141 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to the amendment filed on August 24, 2004, in which claims 1-14, 16-59, 61-104 and 106-141 are presented for further examination.

#### *Response to Arguments*

2. Applicant's arguments with respect to claims 1-14, 16-59, 61-104 and 106-141 have been considered but are moot in view of the new ground(s) of rejection.

#### *Claim Objections*

3. Claims 1-14, 16-59, 61-104 and 106-141 are objected to because of the following informalities: Claim 1 line 6, please replace "to automatic updates of dynamic contact information" to -- *to automatic update the dynamic contact information--*; and line 16, please replace "at lest" to --*at least--*;

Claim 46, line 7, please replace "to automatic updates of dynamic contact information" to -- *to automatic update the dynamic contact information--*; and

Claim 91, line 7, please replace "to automatic updates of dynamic contact information" to -- *to automatic update the dynamic contact information--*. Appropriate correction is required.

#### *Drawings*

4. Applicants are required to furnish the formal drawings in response this office action. No new matter may be introduced in the required drawing. Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

### Information Disclosure Statement

5. The information disclosure statement filed on October 7, 2002, March 2, 2004 and March 5, 2004 complies with the provisions of 37 CFR 1.97 and MPEP § 609. It has been placed in the application file. The information referred to therein has been considered as to the merits.

### *Double Patenting*

6. The non statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 1-14, 16-59, 61-104 and 106-141 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-141 of copending Application No.

09/826,121. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: Claim 1 of the instant application substantially recites the limitations of claim 1 of the cited co-pending application. The claim merely omits certain the underlined limitations as shown in comparison table 1 below.

Application Claim 1	Co-pending Application 1
<p>1. A method in a computer system for providing dynamic contact information, said method comprising the steps of:  <u>establishing a status system, including at least one status server and a plurality of clients;</u>  <u>specifying for a given client within the plurality of clients a plurality of subscribed entities for which the given client subscribes to automatic update the dynamic contact information;</u>  retrieving a plurality of dynamic contact records for a plurality of entities from one or more systems <u>within the status system,</u>  <u>wherein the plurality of subscribed entities is a subset of the plurality of entities;</u>  providing the plurality of dynamic contact records to the at least one status server;  <u>identifying at least one subscribed dynamic contact record from within the plurality of</u></p>	<p>1. A method in a computer system for providing dynamic contact information, said method comprising the steps of:  retrieving dynamic contact records for a plurality of entities from one or more systems representing a dynamic contact information service;  and  providing dynamic contact records to one or more status servers.</p>

<u>dynamic contact records that corresponds to one of the plurality of subscribed entities: and automatically sending, using said at least one status server, at least one subscribed dynamic contact record to e said given client without intervention from an operator of the given client.</u>	

Table 1

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify the cited steps as indicated claim 1 of the present application since the omission and addition of the cited limitations would have not changed the process according to which the method for providing dynamic contact information. Therefore, the ordinary skilled artisan would have been also motivated to modify claim 1 of the cited present US co-pending application by omitting the use of *establishing a status system, including at least one status server and a plurality of clients; specifying for a given client within the plurality of clients a plurality of subscribed entities for which the given client subscribes to automatic update the dynamic contact information; identifying at least one subscribed dynamic contact record from within the plurality of dynamic contact records that corresponds to one of the plurality of subscribed entities: and automatically sending, using said at least one status server, at least one subscribed dynamic contact record to e said given client without intervention from an operator of the given client.* The cited omitting elements would not interfere with the functionality of the steps previously claimed and would perform the same function. In re Karlson, 136 USPQ 184 (CCPA 1963).

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The dependent claims 2-14 and 17-45 of the instant application are similar to the claims 2-46 of the co-pending application. They are rejected for fully incorporating the errors of their respective base claims by dependency.

Claim 46 of the instant application substantially recites the limitations of claim 46 of the cited co-pending application. The claim merely omits certain the underlined limitations as shown in comparison table 2 below.

Application Claim 46	Co-pending Application 46
<p>46. A computer system for providing dynamic contact information comprising: at least one status server; and a plurality of clients; <u>wherein for a given client within the plurality of clients a plurality of subscribed entities for which the given client subscribes to automatic update the dynamic contact information;</u> wherein a plurality of dynamic contact records is retrieved for a plurality of entities from one or more systems representing a dynamic contact information service, wherein <u>the plurality of subscribed entities is a subset of the plurality of entities;</u> wherein the plurality of dynamic contact records are provided to the at least one status server; <u>identifying at least one subscribed dynamic contact record from within the plurality of dynamic contact records that corresponds to one of the plurality of subscribed entities; and automatically sending, using said at least one status server, at least one subscribed dynamic contact record to e said given client without intervention from an operator of the given client.</u></p>	<p>46. A computer system for providing dynamic contact information comprising: dynamic contact records being retrieved for a plurality of entities from one or more systems representing a dynamic contact information service; and dynamic contact records being provided to one or more status servers.</p>

Table 2

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify the cited steps as indicated claim 1 of the present application since the omission and addition of the cited limitations would have not changed the process according to which the method for providing dynamic contact information. Therefore, the ordinary skilled artisan would have been also motivated to modify claim 1 of the cited present US co-pending application by omitting the use of *establishing a status system, including at least one status server and a plurality of clients; specifying for a given client within the plurality of clients a plurality of subscribed entities for which the given client subscribes to automatic update the dynamic contact information; identifying at least one subscribed dynamic contact record from within the plurality of dynamic contact records that corresponds to one of the plurality of subscribed entities; and automatically sending, using said at least one status server, at least one subscribed dynamic contact record to e said given client without intervention from an operator of the given client*. The cited omitting elements would not interfere with the functionality of the steps previously claimed and would perform the same function. In re Karlson, 136 USPQ 184 (CCPA 1963).

The dependent claims 47-59 and 61-90 of the instant application are similar to the claims 47-90 of the co-pending application. They are rejected for fully incorporating the errors of their respective base claims by dependency



Claim 91 of the instant application substantially recites the limitations of claim 91 of the cited co-pending application. The claim merely omits certain the underlined limitations as shown in comparison table 3 below.

Application Claim 91	Co-pending Application 91
<p>91. A computer program product in a computer system for providing dynamic contact information comprising:  <u>instruction means for establishing a status system, including at least one status server and a plurality of clients;</u>  <u>instruction means for specifying for a given client within the plurality of clients a plurality of subscribed entities for which the given client subscribes to automatic update the dynamic contact information;</u>  instruction means for retrieving a plurality of dynamic contact records for a plurality of entities from one or more systems <u>within the status system, wherein the plurality of subscribed entities is a subset of the plurality of entities;</u>  instruction means for providing the plurality of dynamic contact records to the at least one status server;  <u>instruction means for identifying at least one subscribed dynamic contact record from within the plurality of dynamic contact records that corresponds to one of the plurality of subscribed entities; and</u>  <u>instruction means for automatically sending, using said at least one status server, at least one subscribed dynamic contact record to e said given client without intervention from an operator of the given client.</u></p>	<p>91. A computer program product in a computer system for providing dynamic contact information comprising:  instruction means for retrieving dynamic contact records for a plurality of entities from one or more systems representing a dynamic contact information service; and  instruction means for providing dynamic contact records to one or more status servers.</p>

Table 3

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify the cited steps as indicated claim 1 of the present application since the omission and addition of the cited limitations would have not changed the process according to which the method for providing dynamic contact information. Therefore, the ordinary skilled artisan would have been also motivated to modify claim 1 of the cited present US co-pending application by omitting the use of *establishing a status system, including at least one status server and a plurality of clients; specifying for a given client within the plurality of clients a plurality of subscribed entities for which the given client subscribes to automatic update the dynamic contact information; identifying at least one subscribed dynamic contact record from within the plurality of dynamic contact records that corresponds to one of the plurality of subscribed entities: and automatically sending, using said at least one status server, at least one subscribed dynamic contact record to e said given client without intervention from an operator of the given client*. The cited omitting elements would not interfere with the functionality of the steps previously claimed and would perform the same function. In re Karlson, 136 USPQ 184 (CCPA 1963).

The dependent claims 92-105 and 106-135 of the instant application are similar to the claims 92-135 of the co-pending application. They are rejected for fully incorporating the errors of their respective base claims by dependency

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Claim 136 of the instant application substantially recites the limitations of claim 136 of the cited co-pending application. The claim merely omits certain the underlined limitations as shown in comparison table 4 below.

Application Claim 136	Co-pending Application 136
<p>136. A method in a data processing system for managing dynamic contact information, the method comprising:</p> <p>maintaining a user status for the user, wherein the user status is provided to a group of users;</p> <p>receiving dynamic contact information from a client for a user, wherein the dynamic contact information is automatically sent to the data processing system by the client in response to a change in a calendar on the client;</p> <p>responsive to receiving the dynamic contact information, selectively changing the user status for the user based on receiving the dynamic contact information to form changed status information; and</p> <p><u>automatically sending the changed status information to a plurality of subscribing users without interaction from the plurality of subscribing users.</u></p>	<p>136. A method in a data processing system for managing dynamic contact information, the method comprising:</p> <p>maintaining a user status for the user, wherein the user status is provided to a group of users;</p> <p>receiving dynamic contact information from a client for a user, wherein the dynamic contact information is automatically sent to the data processing system by the client in response to a change in a calendar on the client; and</p> <p>responsive to receiving the dynamic contact information, selectively changing the user status for the user based on receiving the dynamic contact information.</p>

**Table 4**

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify the cited steps as indicated claim 1 of the present application since the omission and addition of the cited limitations would have not changed the process according to which the method for providing dynamic contact information. Therefore, the ordinary skilled artisan would have been also motivated to modify claim 1 of the cited present US co-pending application by omitting the use of **automatically sending the changed status information to a plurality of subscribing users without interaction from the plurality of subscribing users**. The cited omitting elements would not interfere with the functionality of

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the steps previously claimed and would perform the same function. In re Karlson, 136 USPQ 184 (CCPA 1963).

The dependent claims 137-141 of the instant application are similar to the claims 137-141 of the co-pending application. They are rejected for fully incorporating the errors of their respective base claims by dependency

### *Claim Rejections - 35 USC § 102*

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 136-141 are rejected under 35 U.S.C. 102(e) as being anticipated by Diacakis et al., (hereinafter "Diacakis") US 2002/0116336.

As to claim 136, Diacakis discloses a system for displaying contact information of a plurality of individuals for a subscriber of the contact information. In particular, Diacakis the claimed "maintaining a user status for the user, wherein the user status is provide to a group of users" detecting that the individual is at work and transmitting the individual's updated P&A information to the client for the individual's boss and spouse ([0034], [0035], fig.4; fig.10); "receiving dynamic contact information from a client for a user, wherein the dynamic contact information is automatically sent to the data processing system by the client in response to a change in a calendar on the client"([0040], [0056], [0058], fig.4; fig.10); "responsive to receive the dynamic contact information, selectively changing user status for the user based on receiving the dynamic contact information to form changed status information" ([0046], [0066], fig.4;

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fig.10); and “ automatically sending the changed status information to a plurality of subscribing users without interaction from the plurality of subscribing users”([0062], fig.4; fig.10).

As to claim 137, Diacakis discloses the claimed “wherein the selectively changing step, changes the status of the user if the dynamic contact information includes a status of the user that is different from a current status of the user” ”([0040], [0056], [0058], fig.4; fig.10).

As to claim 138, Diacakis discloses the “wherein the changes include an identification of at least one of when the user is in an office, at an alternate work location, free, in a meeting, available via cell phone, and available via pager”([0032], [0064], fig.8; fig.10).

As to claim 139, Diacakis discloses the claimed “wherein the changes include dynamic contact Information”[0029], [0034], [0035], [0038]).

As to claim 140, Diacakis discloses the claimed “wherein the client is at least one of a personal digital assistant, a phone, a laptop computer, and a personal computer”[0044]; [0054].

As to claim 141, Diacakis discloses the claimed “wherein the dynamic contact information includes at least one of status information for the user derived from the calendar and Contact information derived from the calendar” ([0054], [0056]).

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*Allowable Subject Matter*

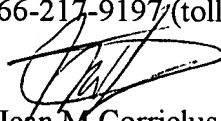
9. Claims 1-14, 16-59, 61-104 and 106-135 would be allowable if rewritten to overcome the double patenting rejection(s), set forth in this Office action.

*Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M Corrielus whose telephone number is (571)272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703)305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jean M Corrielus  
Primary Examiner  
Art Unit 2162

January 20, 2005